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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/202,424 02/19/99 CIRUS

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EXAMINER

MMC2/1012

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ART UNIT

PAPER NUMBER

2876

DATE MAILED:

10/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/202,424

Applicant(s)

Orus et al

Examiner

Tremblay

Group Art Unit

2876

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3 and 14-19 is/are rejected.
- ☒ Claim(s) 4-15 and 20-25 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Serial Number: 09/202,424

Paper #4, Page 2

Applicant: Orus et al.

Filing date: 2/19/99

Claim Objections

5 Claims 4-15 and 20-25 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

10 Claims 1-25 are objected to for containing references to figures. Where possible, claims are to be complete in themselves. Incorporation by reference to a specific figure or table "is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant's convenience." Ex parte Fressola, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted). See MPEP 2173.05(s).

Claim Rejections - 35 USC § 112

15 Claims 1-25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

20 Re claim 1, the second instance of "the method" (line 13) lacks clear antecedent basis. It is unclear what this phrase means, given the previous phrase "the method having the following steps during a gambling operation:". The recital of "and/or" on lines 11, 12 and 18 of claim 1 renders the claim indefinite.

Re claim 16, the use of "and/or" in context renders the claim indefinite.

25 Re claim 18, "in that it additionally comprises" renders the claim indefinite. The referent of "it" is ambiguous.

Claim Rejections - 35 USC § 102

30 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5 Claims 1 and 16 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent #5429,361 to Raven et al. ("Raven" hereinafter).

Claim Rejections - 35 USC § 103

10 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

25 Claims 2-3 and 16-19, are rejected under 35 U.S.C. § 103 as being unpatentable over Raven. Raven discloses the invention according to claim 1, but does not plainly teach the entry into the database of the initial value encoded on a card. However, this is a basic accounting practice, necessary for the invention to work as described. Official Notice is taken that accounting for an initial value of an account is old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to account for the initial value in the Raven system because this would allow the monitoring system taught therein to keep accurate records of the account.

30 Re claims 17-19, the claims correspond to at least two notoriously well known encryption systems. Official Notice is taken that public key cryptography and DES, including the use of secret keys, and security modules which calculate authentication certificates (in each type of system) is old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in

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the art to use public key cryptography or DES to secure the financial transactions taught in Raven. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a known security module to calculate authentication certificates to authenticate the gambling card's certificate.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #5,371,345 to LeStrange, U. S. Patent #5,451,756 to Holzer et al., U. S. Patent #6,110,041, U. S. Patent #5,557,086, U. S. Patent #5,770,533, and U. S. Patent #5,038,022 are cited for showing other card based gambling systems.

Internet


PTO maintains an extensive web site at <http://www.uspto.gov>. Communications about this application via e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be addressed to **mark.tremblay@uspto.gov**. All Internet e-mail communications will be recorded in the application. PTO employees don't use the Internet to exchange sensitive information unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. For more details, see the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Voice

General inquiries or status inquiries about this application should be directed to the Group 2800 Receptionist at (703) 308-0956. Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 9:30 am to 6:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Don Hajec, can be reached on (703) 308-4075. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

Fax Procedures

Application papers may faxed to Art Unit 2876 at (703) 308-7724. Faxes must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers solely for the examiner's consideration, and not intended for immediate entry into the application (e.g., a proposed amendment) should be unsigned and clearly marked "Draft Copy" and/or "Deliver Directly to Examiner."


Mark Tremblay
October 10, 2000